

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OKADA MUNEKI and MORIMOTO KAZUYA

Appeal No. 1998-2139
Application 08/572,727

ON BRIEF

Before COHEN, FRANKFORT, and MCQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 3-11, 13 and 14 which are all of the claims remaining in the application. Claims 1, 2 and 12 have

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been canceled.

Appellants' invention relates to a hollow telescopic fishing rod comprising a fishing rod body (13) having a plurality of hollow fishing rod body sections (14) made from fiber-reinforced resin. The hollow interiors of the plurality of body sections (14) define an internal path (15) for a fishing line (30) and allow the body sections to nest together while in a storage mode. At least one of the body sections (14) including an inner surface in which is formed a spiral groove. The spiral groove defining in cross section a plurality of generally trapezoidal fishing line holding protrusions (40) with inclined sides and arc shaped corners (45, 46) to reduce wear between the line and the protrusions (40), e.g., see Figure 3. A representative copy reproduced from Appellants' brief of independent claim 13 is attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness are:

Akiba

5,488,797

Feb. 6, 1996

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consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness (see In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992)), which is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art (see In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)). The conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

With this as background, we turn to the examiner's rejection of independent claim 13 under 35 U.S.C. § 103 as being unpatentable over Akiba in view of Harada. The examiner (answer, pages 3-4) is of the view that Akiba discloses a hollow telescopic fishing rod comprising a fishing rod body (12, 14, 16) having a plurality of body sections (14, 16) wherein said body sections (14, 16) are formed from fiber reinforced resins. It is further urged that the hollow fishing rod body includes trapezoidal shaped line holding protrusions (53, Figure 13). The examiner notes that Akiba does not disclose the line holding protrusions to be in a spiral pattern, as having arc shaped corners and as being formed by a monobloc forming method. Harada is relied upon by the examiner to provide line holding protrusions in a spiral pattern. With respect to the "arc shaped corners" required in claim 13 on appeal, the examiner asserts that such corners are well within the "purview of the ordinary artisan", since the ordinary artisan would have fully realized that a sharp cornered line guide would quickly and undesirably abrade the fishing line and therefore would have provided rounded or arc shaped corners on the line holding protrusions. As for the

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requirement in appellants' claim 13 that the spiral pattern of protrusions be formed by "monobloc forming", the examiner has taken the position (answer, page 4) that "monobloc forming" is a method of making that fails to impart patentability in an article claim, since the article may be formed by alternative methods. With respect to the specific dimensions set forth in dependent claims, the examiner relies only on each being found to be a choice of design determined through routine experimentation and further dependent on the size of the fishing rod.

As to appellants' arguments, we agree with appellants (brief, pages 7-8) that the examiner has failed to adduce any textual support for the assertion that it would have been "within the purview" of the skilled artisan to produce arc-shaped corners on the line-holding protrusion from Akiba or Harada. Appellants' further argument that the mere asserted ability of the artisan to do something is not determinative of obviousness under 35 U.S.C. § 103, is also agreed with. The law is clear that "the mere fact that the prior art could be so modified would not have made the modification obvious

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unless the prior art suggested the desirability of the modification." In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). After reviewing the prior art, the examiner's rejection and the appellants' arguments, we agree with the appellants that the examiner has failed to show any teaching in the prior art of the desirability of providing arc shaped corners on the protrusions of the fishing rod sections resulting from the combination of Akiba and Harada.

It is well settled that a rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he/she advances. The examiner may not, because he/she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). In the present case, absent the required factual basis on the examiner's part, the rejection of appellants' claim 13 under 35 U.S.C. §

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103 cannot be sustained. It follows that the examiner's rejection of claims 3-11 and 14, which depend from claim 13, will also not be sustained.

CONCLUSION

The decision of the examiner to reject claims 3-11, 13 and 14 under 35 U.S.C. § 103 as being unpatentable over Akiba

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in view of Harada is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge))
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)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
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